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SERIAL NUMBER	REQUEST DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/786,027	8/8/01	STEPHAN RAYMOND ACHS, ET AL	38827/205276

Title: **ENERGY GUIDE CHAIN FOR GUIDING LINES
COMPRISING CHAIN LINKS WHICH CAN MOVE IN
THREE DIMENSIONS**

Art Unit	Paper Number
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Grant Date: 08-Nov-07

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on the attached decision.**

Approved:


for Commissioner of Patents and Trademark

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LICENSE FOR FOREIGN FILING

[Title 35, United States Code (1952) Sections 184, 185, 186]



UNITED STATES PATENT AND TRADEMARK OFFICE

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In re: Achs et al : DECISION ON REQUEST
Serial No.: 09/786,027 : UNDER 37 CFR 5.25
Filing date: May 15, 2001
Docket No: 038827/205276

**Title: ENERGY GUIDE CHAIN FOR GUIDING LINES COMPRISING CHAIN LINKS
WHICH CAN MOVE IN THREE DIMENSIONS**

This is a decision on the petition filed on November 6, 2006 for retroactive foreign filing license.

It has been determined that a retroactive license for foreign filing under 35 U.S.C.184 be granted with respect to the filings listed below. The petition complies with 37 C.F.R. 5.25 in that there is an adequate showing that the subject matter in question was not under a secrecy order, that the license was diligently sought after discovery of the proscribed foreign filing, and that the material was filed abroad without the required license under 37 C.F.R 5.11 through error and without deceptive intent.

Country

Date

GERMANY

August 31, 1998

Ian J. Lobo
Patent Examiner
(571) 272-6974

Attorney's Docket No. 038827/205276

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Achs et al. Confirmation No.: 3993
Appl. No. 09/786,027 Filed: May 15, 2001
Patent No.: 6,550,232 Issue Date: April 22, 2003
For: ENERGY GUIDE CHAIN FOR GUIDING LINES COMPRISING
CHAIN LINKS WHICH CAN MOVE IN THREE DIMENSIONS

Attn: **Licensing and Review**
Commissioner for Patents
P. O. Box 1450
Alexandra, VA 22313-1450

**RENEWED PETITION FOR RETROACTIVE LICENSE
37 CFR §5.25**

Sir:

This is a renewal of the Petition for a Retroactive License under 37 CFR §5.25 filed on June 11, 2001, and is responsive to the Decision on Request mailed on June 5, 2006.

The Decision on Request denied the original petition on the basis that the requirements of 37 CFR 5.25(a)(3)(iii) were not fully met. Specifically, the Decision on Request held that since the German counsel had knowledge and made the actual decision to file the application abroad, a verified statement from the German counsel should be made, in which the circumstances surrounding the proscribed filings, including the discovery of the proscribed filings, are explained.

To comply with the stated requirement, attached is a Declaration of Mr. Ditmar Neumann of Erkelenz, Germany. As stated in the Declaration, Mr. Neumann was a member of the firm Bardehle Pagenberg Dost Altenburg Geissler (BDL) in Germany, and is now a member of Kahlhöfer, Neumann, Heilein (KNH) in Düsseldorf, Germany, and he was responsible for the preparation and filing of the applications in question.

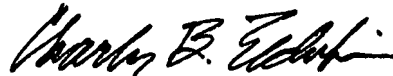
Mr. Neumann also states that the instructions for filing the applications in question gave no indication that the

invention may have been made in the U.S., and that a foreign filing license under 35 USC §184 might be required. Thus the applications were filed in a routine manner by his office in Germany, without first seeking a foreign filing license.

The Declaration by Mr. Neumann also states that he first became aware of the possible application of 35 USC §184 to the application in question, upon receipt of a letter dated March 15, 2001 from their U.S. associates.

It is respectfully submitted that the requirements of 37 CFR 5.25(a) have been fully met, and that the request for a retroactive foreign filing license should be granted. Such action is solicited.

Respectfully submitted,



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450
ATTN: Licensing and Review

DECLARATION OF DITMAR NEUMANN

I, Ditmar Neumann, declare the following:

1. I am a citizen of Germany, residing at Erkelenz, Germany.
2. I am a licensed Patentanwalt in Germany, and also a licensed European Patent and Trademark Attorney. Beginning about 1994, I was a member of the firm Bardehele Pagenberg Dost Altenburg Geissler (BDL), which is located in Düsseldorf and Munich, Germany.
3. Beginning about 1992, BDL has represented Kabelschlepp GmbH, a German corporation located in Siegen, Germany, in connection with its patent and other intellectual property matters. Since about 1994, I was the patent attorney within BDL, who was responsible for the work performed by BDL for Kabelschlepp GmbH.
4. In March of 1998, Kabelschlepp authorized BDL to file a patent application in Germany relating to an energy chain which was suitable for a sliding door system of a van, which had been developed by employees of the company. German patent application No. 198 39 575.2 was accordingly filed in Germany on August 31, 1998. The application was filed without designating the inventors, which is permissible under German law, and at that time our office was unaware of the names and nationalities of the inventors.

5. A few days before the end of the one year priority period, BDL receive a fax from Ms. Ossenbergh of Kabelschlepp GmbH asking BDL to file a corresponding international application under the PCT, and listing the names and nationalities of the three inventors, which is required for the PCT filing. There was nothing in the fax, or in any other information that was provided to BDL by Kabelschlepp, that caused a question to be raised whether any part of the invention may have been made in the U.S. BDL therefore proceeded to file the following application, in the normal manner.

- PCT International Application No. PCT/EP99/06373 filed on August 13, 1999 in the European Patent Office.

6. During 2000, I and several other patent attorneys formed the firm Kahlhöfer Neumann Heilein (KNH) in Düsseldorf, Germany, which continued to represent Kabelschlepp. The office of KNH proceeded to file the following applications:

- Japanese National Phase Patent Application No. 2000-567863 filed February 20, 2001.
- European National Phase Patent Application (designating Germany, France, and Italy) No. EP 9906373 filed February 28, 2001.
- U.S. National Phase Application 09/786,027, filed February 28, 2001.

6. After filing the U.S. national phase applications, KNH received a letter dated March 15, 2001 from our U.S. associates which for the first time raised the question whether the invention was made in the U.S. and whether we needed to file a Petition for a retroactive foreign filing license under the provisions of 35 USC §184. This was the first time anyone in our office became aware of the possible


requirement for a foreign filing license under U.S. law with regard to the above referenced patent applications.

7. Subsequent to March 15, 2001, I corresponded with our U.S. associates, and our U.S. associates corresponded directly with Stephan Achs who was one of the named inventors, to determine the facts surrounding the conception and development of the invention. Based upon this correspondence, it was decided that we should file a Petition for a retroactive foreign filing license under 37 CFR 5.25, and the Petition was filed on June 11, 2001.

8. The invention as disclosed in the above referenced patent applications was not under a secrecy order at the time of their filings, and it is not currently under a secrecy order.

9. It is my belief that the above referenced patent application filings which occurred without first obtaining a foreign filing license from the U.S. authorities, occurred through error and without deceptive intent, and I believe that the U.S. attorneys and KNH made a diligent effort to ascertain the circumstances surrounding the invention and apply for a license as required by U.S. law and regulations.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the subject patent.


Ditmar Neumann
Date: 6. Nov. 2006